

REMARKS

This communication is responsive to the Final Office Action dated April 1, 2009. The claims are not amended by way of this communication. Claims 12 and 13 were canceled in a previous Amendment. Claims 1-11 and 14-17 remain pending. Applicant respectfully requests reconsideration in light of the arguments presented below.

Claim Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 1–11 and 14–17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013613 to Haller et al. (“Haller”). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest each and every feature of the inventions defined by Applicant’s claims. Furthermore, there would have been no rational reason for the modification of the Haller system to include such features.

Applicant initially notes that the Examiner has mischaracterized the invention. On page 3, line 16, the Examiner states, “[t]he invention is drawn to a contract including a clause to reimburse the operator.” Applicant disagrees. Claim 1 is directed to a *method* of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator. In no manner is claim 1 directed to a *contract*, as asserted by the Examiner. Although claim 1 recites “maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount” as part of the claimed method, an act of maintaining a contractual relationship does not mean that claim 1 is directed to a contract.

Claim 1

The applied references fail to teach or suggest all the elements of claim 1. Claim 1 recites the following:

A method of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator, the method comprising:
 receiving a pre-determined monetary amount as a premium from the operator;
 maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary

amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party;

determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time; and

in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.

As argued previously, and as admitted by the Examiner¹, Haller fails to teach a method of directed to an *external* defibrillator. However, the Examiner continues to argue that the recitation of an external defibrillator is merely a recitation of intended use that must result in a *structural* difference to patentably distinguish claim 1 from Haller. Applicant respectfully disagrees for at least the reasons stated in Applicant's previous submission.

Furthermore, the MPEP provides guidance on how to determine whether elements recited in the preamble are structural limitations or statements of use:

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use 'can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.' MPEP § 2111.02, quoting *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966.

It appears that the Examiner has not reviewed the "entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim," as required by case law and the MPEP. The MPEP provides exemplary case law in order to aid in determining whether preamble recitations are structural limitations or mere statements of purpose or use:

In a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for

¹ Final Office Action mailed April 1, 2009, page 3.

which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia. MPEP § 2111.02, citing *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003).

In construing the claims, the *Jansen* Court made use of the well-known rule that “a preamble is treated as a limitation if it gives life and meaning to the claim.” *Jansen* at 1158, quoting *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951)(internal quotations omitted). Like in *Jansen*, the preamble of claim 1 is “not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed.” *Id.*

Federal Circuit case law provides further guidance on how to determine whether terms in the preamble limits the claimed invention. In *Eaton Corp. v. Rockwell International Corp.*, 323 F.3d 1332, 1339, 66 USPQ2d 1271 (Fed. Cir. 2003), the Court stated, “When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”

The preamble of claim 1 recites, “A method of compensating an **operator** of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator.” It is clear after reviewing the entirety of the record that the plain language of the preamble of claim 1 is a statement of the intentional purpose for which the method must be performed. For example, in addition to using the term “external defibrillator” in the preamble, Applicant uses the term “defibrillator” five times in the body of claim 1. Similarly, in addition to using the term “operator” in the preamble, Applicant uses the term “operator” six times in the body of claim 1. Applicant clearly intended that the method of claim 1 be performed in conjunction with an external defibrillator. Hence, the preamble of claim 1 gives life and meaning to the claim. Furthermore, because terms such as defibrillator and operator in the body of the claim “rely upon and derive antecedent basis from the preamble,” the preamble acts “as a necessary component of the claimed invention. *Eaton Corp.*, 323 F.3d at 1339. As such, the preamble and, in particular, the phrases “external defibrillator” and “operator,” is **not** merely a statement of intended use and is instead entitled to patentable weight. Because the phrases “external defibrillator” and

“operator” are entitled to patentable weight and because Haller fails to teach or suggest a method that uses an external defibrillator, the method of claim 1, namely a method of compensating an operator of an **external** defibrillator for expenses incurred as a result of use of the defibrillator to treat another party, i.e., other than the operator, is non-obvious over Haller.

In addition, Haller fails to disclose or suggest reimbursing the operator of an external defibrillator, as in claim 1. Haller discloses reimbursing **a patient**. Claim 1 explicitly recites “an operator” and “another party to whom the operator has no duty to provide use of the defibrillator.” An operator is different from a patient or another party to whom the operator has no duty to provide use of the defibrillator. A patient, e.g., a person requiring use of the external defibrillator, would not use the external defibrillator on himself or herself. Thus, Haller fails to disclose or suggest reimbursing the **operator** of an external defibrillator, as in claim 1.

In addition, Applicant incorporates by reference the arguments previously presented in the Amendment filed December 31, 2008. As previously argued, Haller fails to teach or suggest receiving a pre-determined monetary amount as a premium from an operator of an external defibrillator, and maintaining a contractual relationship with the operator for a period of time in exchange for the predetermined monetary amount, as required by claim 1. Haller also fails to teach or suggest determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time. Because Haller fails to teach or suggest all the elements of claims 1, claim 1 is non-obvious over Haller. Applicant requests that the rejection be withdrawn and that claim 1 be allowed.

Independent Claims 15 and 16

Independent claims 15 and 16 recite limitations similar to those of independent claim 1. For at least the reasons discussed above with respect to claim 1, Haller does not disclose or suggest all features of Applicant’s independent claims 15 and 16. Applicant respectfully requests that the rejection of these claims be withdrawn.

Dependent Claims

Dependent claims 2-11, 14, and 17 incorporate all the subject matter of claim 1 and add additional subject matter, making them patentable as well over Haller. Furthermore, the dependent claims recite features not disclosed or suggested by Haller.

For example, with respect to amended claim 4, Haller does not disclose or suggest receiving the pre-determined monetary amount upon purchase of the defibrillator by the

operator. The Examiner argued that receiving a service and providing a change for the service as discussed at paragraph 185 of Haller are the same as this requirement. This is plainly incorrect, as paragraph 185 has nothing to do with purchasing a defibrillator, and therefore cannot be the same as receiving the pre-determined monetary amount upon purchase of the defibrillator by the operator.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

June 1, 2009

SHUMAKER & SIEFFERT, P.A.

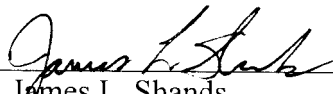
1625 Radio Drive, Suite 300

Woodbury, Minnesota 55125

Telephone: 651.286.8364

Facsimile: 651.735.1102

By:



Name: James L. Shands

Reg. No.: 54,439